

### **REMARKS**

The Examiner's Answer of May 7, 2010, ("the Examiner's Answer") and the final Office Action mailed July 16, 2009, have been carefully reviewed and the remarks that follow are responsive thereto. Claims 1-3, 6-11, 14-16, and 27-30 have been amended. No claims have been canceled. Claims 4-5, 12-13, and 17-26 were previously canceled. No claims have been added. No new matter has been introduced.

Claims 1-3, 6-11, 14-16, and 27-30 thus remain pending. Reconsideration and allowance of the instant application are respectfully requested.

#### ***Claim Rejections Under 35 U.S.C. § 112***

Claims 1-3, 6-11, 14-16, and 27-30 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Without acquiescing to the rejection, and in order to expedite prosecution, Applicant has amended claims 1-3, 6-11, 14-16, and 27-30 to be in more preferred form. Applicant respectfully submits that, as amended, claims 1-3, 6-11, 14-16, and 27-30 comply with the written description requirement. Thus, Applicant respectfully requests that these rejections be withdrawn.

Nevertheless, to preemptively address any remaining concerns that the Examiner may have with regard to the written description requirement of 35 U.S.C. § 112, Applicant respectfully provides the following remarks. According to recent Federal Circuit precedent, "the hallmark of written description is disclosure." *Ariad Pharmaceuticals Inc. v. Eli Lilly & Co.*, 94 USPQ2d 1161, 1172 (Fed. Cir. March 22, 2010). Thus, to test for compliance with the written description requirement, an objective inquiry should be made into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, it should be determined whether the specification describes an invention understandable to that skilled artisan and shows that the inventor actually invented the invention claimed. *Ariad* at 1172.

In its "Response to Arguments," the Examiner's Answer notes that the portions of U.S. Patent Application Serial No. 09/488,361, which was originally incorporated by reference into the instant Application, and which has since issued as U.S. Patent No. 6,421,067, ("the '067 patent") disclose an electronic program guide ("EPG") that indicates which buttons on a remote control device are appropriate for performing functions for the EPG. The Examiner's Answer asserts, however:

[T]he '067 Patent fails to teach that a web-enabled cellular phone is used as a remote control device. The Examiner further notes that the '067 Patent fails to teach that the remote control unit contains a display screen for displaying an EPG. Therefore the '067 Patent fails to provide support for the claims.

Examiner's Answer at 11-12.

At the outset, Applicant notes that the issue properly considered is not whether the '067 patent provides support for the claims, but whether the Specification of the instant Application meets the written description requirement as it was articulated in *Ariad*. For the reasons further discussed below, Applicant respectfully submits that claims 1-3, 6-11, 14-16, and 27-30 satisfy the written description requirement.

Indeed, in considering the four corners of the Specification from the perspective of a person of ordinary skill in the art, it becomes apparent that the Specification clearly describes an invention understandable to a skilled artisan and shows that the inventor actually invented the invention claimed. For instance, the Specification states:

As shown in FIG. 1, it is possible for several people to watch programming on video display 105 while one or more other persons uses computing device 150 to view an EPG on display screen 158. As a result, the programming displayed on video display 105 is undisturbed, and those perusing an EPG using computing device 150 can do so at their leisure. Also, because the EPG is shown on computing device 150, it is more easily customized and can be seen more clearly.

Specification at paragraph [0029] (emphasis added). Thus, the Specification describes displaying an electronic programming guide on a computing device. In addition, the Specification states:

Computing device 150 comprises a computer 156, a display screen 158, an input device 160, and connections 162a and 162b. Computer 156 may be any device, such as a Personal Computer (PC), a Personal Digital Assistant (PDA), or a web phone, capable of processing commands necessary to display output on display screen 158. Display screen 158 may be a computer monitor or an LCD screen, or any other device capable of displaying the output of computer 156.

Specification at paragraph [0026] (emphasis added). Thus, the Specification describes that a web phone may be the computing device on which the electronic programming guide is displayed. In addition, the Specification further states:

A wireless hand held device, such as hand held unit 220 allows for a great deal of flexibility. A user may move about the room which contains video display 105 and be able to control the functions of the EPG from any point. When using a wireless hand held device to control the EPG, the device may also assume the functions of remote control device 120.

Specification at paragraph [0036] (emphasis added). Thus, the Specification describes using a wireless hand held device to remotely control a video display and an electronic programming guide. Furthermore, despite the Examiner's Answer's assertion that "the specification fails to teach that the hand held unit 220 is a web-enabled phone," it would be clear to a person of ordinary skill in the art that a web phone is a wireless hand held device. Indeed, most (if not all) web phones are devices that employ wireless technology and are held in a person's hand. To reinforce this point, Applicant notes that the Specification also states:

FIG. 3 illustrates a system 105 and a number of wireless hand-held devices. In one embodiment, hand held units 310a-n can display an EPG for entertainment system 100 on their screens. However, hand-held units 310a-n are capable of communicating either with STB 205 through antennae 315a-n or with STB 205 through network 125. Hand held devices 310a-n may communicate with network 125 via multiple techniques, including but not limited to cellular, PCM, satellite, Blue-Tooth.TM., etc. In one embodiment, the handheld units would communicate with the satellite 235 or other alternative features.

Specification at paragraph [0038] (emphasis added). Thus, the Specification describes hand held devices with cellular capabilities, such as web phones, displaying an electronic programming guide on their display screens.

In sum, Applicant respectfully submits that in considering the foregoing passages and the other portions of the Specification from the perspective of a person of ordinary skill in the art, it becomes apparent that the Specification clearly describes a web phone being used as a remote control device and an electronic programming guide being displayed on a display screen of such a web phone. For at least these reasons, Applicant respectfully submits that claims 1-3, 6-11, 14-16, and 27-30 satisfy the written description requirement and respectfully requests that the rejections under 35 U.S.C. § 112 be withdrawn.

***Claim Rejections Under 35 U.S.C. § 103***

Claims 1-3, 6, 9-11, 14, 28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2005/0028208 of Ellis et al. ("the Ellis publication") in view of U.S. Patent No. 6,774,926 to Ellis et al. ("the Ellis patent") in further view of U.S. Patent No. 5,936,611 to Yoshida ("Yoshida"). Claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ellis publication in view of the Ellis patent in further view of Yoshida in further view of U.S. Patent No. 6,754,904 to Cooper et al. ("Cooper"). Claims 8 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ellis publication in view of the Ellis patent in further view of Yoshida in further view of U.S. Patent No. 6,246,441 to Terakado et al. ("Terakado"). Claims 27 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ellis publication in view of the Ellis patent in further view of Yoshida in further view of U.S. Patent No. 6,853,308 to Dustin ("Dustin"). For the reasons set forth below, Applicant respectfully traverses these rejections.

Amended independent claim 1 recites, *inter alia*, indicating on the first web phone, based on the displayed electronic programming guide, that at least one button of the first web phone is appropriate for performing an action associated with the electronic programming guide. Applicant respectfully submits that the Ellis publication, the Ellis patent, and Yoshida, whether applied alone or in combination, fail to teach or suggest such features.

The Examiner's Answer concedes that the Ellis publication and the Ellis patent "are silent as to the EPG including an indication of which web-enabled cellular phone buttons are appropriate for the EPG." Examiner's Answer at 6. Indeed, the Examiner's Answer states that "[w]hile Ellis ('926 Patent) teaches the use of a web-enabled cellular phone to make EPG selections, neither Ellis reference teaches indicating to the user which buttons can be used for a particular set of functions." Examiner's Answer at 6. However, the Examiner's Answer asserts:

Yoshida discloses an EPG that displays an image of the remote control the viewer is using (see Figure 7). The remote control image on the display further provides an indication to the user each [*sic*] key's functionality when a user presses the key on the remote control (see Figures 7-9 and Column 6, Line 30 through Column 8, Line 29).

Examiner's Answer at 6-7. In addition, the Examiner's Answer asserts:

The Ellis '208 Publication and Ellis '926 Patent teach a web-enabled cellular phone that displays a program guide while the Yoshida reference discloses displaying a help screen that indicates which

buttons a remote control device that are appropriate for performing functions for the EPG (see Figure 8 and Column 6, Lines 30-65 and Table 1 for when the channel up or down key is pressed, indicating that the channel up or down button is used to perform a previous or next channel selection in a channel guide/EPG). Specifically Table 1 clearly teaches that the description for explaining functions on a remote control include that the channel up and channel down button displays a message stating "GO TO THE NEXT CHANNEL WHEN TUNING AND IN CH. GUIDE". Therefore Yoshida clearly teaches indicating which buttons are appropriate for performing functions for the EPG.

Examiner's Answer at 12-13.

Applicant notes, however, that Yoshida states:

According to the present invention, when a predetermined key, for example, the MENU key (or HELP key which is not shown in FIG. 2) on the remote control hand unit 10 is pressed, the mode is changed over to the help mode and the remote control hand unit body 10 and its keypad are graphically displayed on the screen (the display screen) of the CRT 9 by performing the predetermined operation. When the user presses a key on the remote control hand unit 10, the corresponding key displayed graphically on the display screen blinks or changes in color. At the same time, the functional description (the main points of the functional description described in the manual) of the key is displayed on the display screen.

Yoshida at 4:52-64 (emphasis added). Thus, in Yoshida, a user presses a key on the remote control hand unit and a functional description of the key is displayed on the remotely controlled display screen. Yoshida lacks any teaching or suggestion, however, of indicating on the first web phone, based on the displayed electronic programming guide, that at least one button of the first web phone is appropriate for performing an action associated with the electronic programming guide, as recited in claim 1. Moreover, even assuming, without conceding, that the Ellis publication, the Ellis patent, Cooper, Terakado, and Dustin are properly combinable with or without Yoshida, no combination thereof would cure the above-discussed deficiencies of Yoshida.

For at least these reasons, claim 1 is allowable. In addition, amended independent claim 9 recites similar features as claim 1, and thus, claim 9 is allowable for substantially the same reasons as claim 1.

Claims 2-3, 6-8, 10-11, 14-16, and 27-30 ultimately depend from one of amended independent claims 1 and 9, and therefore are allowable by virtue of their dependence and further in view of the various features recited therein.

### **CONCLUSION**

All issues having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or if there are any questions, the Examiner is invited to contact the undersigned at (202) 824-3161.

Respectfully submitted,  
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